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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/519,907	12/15/2005	Philip Course	72882-011 (WRAJ-001US)	2915
23630 7590 01/04/2010 MCDERMOTT WILL & EMERY LLP 28 STATE STREET BOSTON, MA 02109-1775			EXAMINER HAMMOND III, THOMAS M	
			ART UNIT	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

BostonIPDocket@mwe.com

Office Action Summary	Application No. 10/519,907	Applicant(s) COURSE ET AL.	
	Examiner THOMAS M. HAMMOND III	Art Unit 3695	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) 15-26 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Status of Claims

1. This Office Action is responsive to the Applicant's response filed 21 August 2009.
2. Claims 1-14 (Group I) have been elected. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
3. Claims 1-14 are currently pending and have been examined

Examiner Note

4. Examiner Perry is no longer prosecuting the instant application. All further correspondence will be conducted by Examiner Thomas Hammond.

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Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

6. Claims 1, 4, 6, 10, and 12-14 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

7. Regarding claims 1 and 4, the Applicant recites the limitation, "the provision of the good or service...". However, there is no antecedent basis for this limitation recited in the claim. Therefore it is unclear to the Examiner what the scope of such limitation is sought by the Applicant. For the purposes of examination, the Examiner will interpret such limitation as *any provision* of the good or service. Furthermore, claim 1 recites limitations using the phrase "if applicable", implying that such limitation are not positively set forth in the claim and therefore making the scope of the claimed invention unclear. For the purposes of examination, the Examiner will assume that such limitations are positively set forth.

8. Regarding claim 6, the Applicant recites the limitation, "with the EFT terminal". However, there is no antecedent basis for this limitation, as claims 5, 4, and 1, do not require an EFT terminal because of the alternative language of claim 5. For the purposes of examination, the Examiner will interpret such limitation as having antecedent basis in claim 5.

9. Regarding claim 10, the Applicant recites the limitation, "the business broker". However, there is no antecedent basis for this limitation. For the purposes of examination, the Examiner will interpret this limitation as any entity associated with the payment system.

10. Regarding claims 12-14, the Applicant recites the limitation, "the prescribed proportion...". However, there is no antecedent basis for this limitation, as claims 1 and 4, do not require. For the purposes of examination, the Examiner will interpret such limitation as having antecedent basis in claims 1 and 4.

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Claim Rejections - 35 USC § 102

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

12. Claims 1, 4-6, 11, 12, and 14 are rejected under 35 U.S.C. 102(e) as being anticipated by *O'Leary et al.*, US Patent 6,609,113 (hereinafter "*O'Leary*").

As per claim 1

O'Leary teaches:

- entering into an agreement with the commercial provider to provide a good or service to a potential customer of the merchant for valuable or other consideration (see at least C2/L43-59)
- entering into an agreement with the merchant to offer the good or service of the commercial provider to its customers for valuable or other consideration (see at least C3/L39-56)
- electronically transacting with the customer of the merchant the provision of the good or service of the commercial provider to the customer (see at least C7/L13-24)
- using an electronic payment system to handle payment of a good or service of the commercial provider purchased by a customer of the merchant (see at least C7/L13-24)
- electronically authorising the provision of the good or service of the commercial provider upon confirmation of payment by the electronic payment system (see at least C7/L13-24)
- electronically distributing the valuable consideration in respect of the payment to the commercial provider, if applicable, in accordance with the agreement made with the commercial provider (see at least C2/L43-59)

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- electronically distributing the valuable consideration in respect of the payment to the merchant, if applicable, in accordance with the agreement made with the merchant (see at least C3/L39-56)

As per claim 4

Claim 4, as best understood by the Examiner, encompasses the same or substantially the same scope as claim 1. Accordingly, claim 4 is rejected in the same or substantially the same manner as claim 4.

As per claim 5

O'Leary teaches the method of claim 1 or 4, as shown above.

O'Leary further teaches:

- wherein the terminal device is one of an EFT terminal, a mobile telephone or portable digital assistant (see at least C7/L13-24)

As per claim 6

O'Leary teaches the method of claim 5, as shown above.

O'Leary further teaches:

- wherein the primary payment for the good or service is paid for by way of an electronic transfer of funds from the payment system associated with the EFT terminal (see at least C7/L13-24)

As per claim 11

O'Leary teaches the method of claim 1 or 4, as shown above.

O'Leary further teaches:

- wherein primary payment for the service or product may be paid for directly by the customer (see at least C8/L41-58)

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As per claim 12

O'Leary teaches the method of claim 6, as shown above.

O'Leary further teaches:

- the terminal device communicating the particular manner of the transacting payment to the provider, and the provider effecting the electronic distribution of the prescribed proportion based on the manner of such payment (see at least C7/L13-24)

As per claim 14

O'Leary teaches the method of claim 10, as shown above.

O'Leary further teaches:

- the terminal device communicating the particular manner of the transacting payment to the provider, and the provider effecting the electronic distribution of the prescribed portion based on the manner of such payment (see at least C7/L13-24)

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Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over *O'Leary* in view of *Applicant's Admitted Prior Art (hereinafter "AAPA")*.

As per claim 2

O'Leary teaches the method of claim 1, as shown above.

O'Leary further teaches:

- electronically distributing the prescribed proportion or fixed sum of the payment to the sponsor of the terminal device in accordance with the agreement made with the sponsor of the terminal device (see at least C2/L43-59)

O'Leary does not teach:

- entering into an agreement with a sponsor of a terminal device of the electronic payment system to use the terminal device in handling payment for a good or service of the commercial provider purchased by a customer of the merchant, agreement being provided in return for a prescribed proportion of the price of the good or service or fixed sum

AAPA teaches:

- entering into an agreement with a sponsor of a terminal device of the electronic payment system to use the terminal device in handling payment for a good or service of the commercial provider purchased by a customer of the merchant, agreement being provided in return for a prescribed proportion of the price of the good or service or fixed sum

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However, it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include the third-party sponsor entity of a terminal device which agrees to be provided a fee for its services with the transaction system of O'Leary. One would have been motivated to do so in order to provide a user the ability to securely pay anyone, virtually anywhere (see at least O'Leary C4/L38-53). Furthermore, the Supreme Court has supported in, *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007), that merely combining well known elements, using well known methods, to yield a predictable result does not render an invention patentably distinct over such combination. In the instant case, the Applicant's admission that third party sponsors are well known entities in the transaction process is evidence that the technology to include such feature in the transaction process of O'Leary is also well known. The result of such combination would be predictable because the principal functionality of O'Leary is not changed by adding a third party sponsor in the transaction process. Accordingly, the claimed invention is obvious over O'Leary/AAPA.

15. Claims 3, 7-10, and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over *O'Leary* in view of *OFFICIAL NOTICE*.

As per claim 3

O'Leary teaches the method of claim 1, as shown above.

O'Leary does not teach:

- where the step of using an electronic payment system to handle payment of a good or service of the commercial provider purchased by a customer of the merchant includes the sub-step of electronically drawing on an electronic bank account of the merchant to pay for the good or service of the commercial provider purchased by the customer

However, the Examiner takes OFFICIAL NOTICE that drawing on an electronic bank account of a merchant to pay for the good or service of the commercial provider purchased by the customer is old and well known. Such a feature can regular be found in your neighborhood grocery store, where you can pay your utility bills in person as a transaction conducted by the store which, in turn, reimburses the utility company for the money owed by the

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consumer for the particular bill. It would have been obvious to one of ordinary skill in the art, at the time of the invention, to include such a feature and one would have been motivated to do so in order to provide a user the ability to securely pay anyone, virtually anywhere (see at least O'Leary C4/L38-53). Furthermore, the Supreme Court has supported in, *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007), that merely combining well known elements, using well known methods, to yield a predictable result does not render an invention patentably distinct over such combination. In the instant case, the Examiner's assertion and real-world example of this feature is evidence that the technology to include such feature in the transaction process of O'Leary is also well known. The result of such combination would be predictable because the principal functionality of O'Leary is not changed by adding a utility payment-type feature. Accordingly, the claimed invention is obvious over O'Leary/OFFICIAL NOTICE.

As per claim 7

O'Leary teaches the method of claims 1 or 4, as shown above.

O'Leary does not teach:

- wherein the provider of the electronic authorizing to the commercial provider for the provision of the good or service, the provider of the electronic transacting with the customer for the provision of the good or service to the customer, and the provider of the electronic distributing of the valuable consideration to the commercial provider and the merchant, if applicable, with the payment system, is the same provider

However, the Examiner takes OFFICIAL NOTICE that the providers of electronic authorization, electronic transactions, and electronic distribution of payment, can be a single entity, is old and well known in the transaction arts. Furthermore, such feature is merely a design choice of the Applicant as it does not materially affect the operation of the claimed invention. Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include such a feature. One would have been motivated to do so in order to provide a user the ability to securely pay anyone, virtually anywhere (see at least O'Leary C4/L38-53). Furthermore, the Supreme Court has supported in, *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007), that

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merely combining well known elements, using well known methods, to yield a predictable result does not render an invention patentably distinct over such combination. In the instant case, the Examiner's assertion of the Applicant's design choice is evidence that the technology to include such feature in the transaction process of O'Leary is also well known. The result of such combination would be predictable because the principal functionality of O'Leary is not changed by choosing that the individual providers be the same entity. Accordingly, the claimed invention is obvious over O'Leary/OFFICIAL NOTICE.

As per claims 8 and 9

O'Leary/OFFICIAL NOTICE teaches the method of claim 7, as shown above.

O'Leary does not teach:

- wherein the provider contracts with the merchant to pay the merchant a sales commission for a good or service that the merchant is able to sell or provide to a customer
- wherein the merchant pays a fee to the provider for the provision of a good or service that adds value to the merchant's business

However, the Examiner takes OFFICIAL NOTICE that agreements to pay fees or sales commissions is old and well known in the business arts. Some examples of these features can be found in the consulting and retail fields. Therefore it would have been obvious to one of ordinary skill in the art, at the time of the invention, to include such a feature. One would have been motivated to do so in order to provide a user the ability to securely pay anyone, virtually anywhere (see at least O'Leary C4/L38-53). Furthermore, the Supreme Court has supported in, *KSR International Co. v. Teleflex Inc. (KSR)*, 550 U.S. ___, 82 USPQ2d 1385 (2007), that merely combining well known elements, using well known methods, to yield a predictable result does not render an invention patentably distinct over such combination. In the instant case, the Examiner's assertion that fees and sales commissions are old and well-known are indications that the technology to add such features is readily available. Moreover, the result of such combination would be predictable because the principal functionality of O'Leary is not changed by including various fee and commission structures to perform the functions of the claimed invention. Accordingly, the claimed invention is obvious over O'Leary/OFFICIAL NOTICE.

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As per claim 10

O'Leary/OFFICIAL NOTICE teaches the method of claim 7, as shown above.

O'Leary further teaches:

- wherein the primary payment for the provision of a good or service is paid for by way of an electronic transfer of funds from a payment system associated with the business broker (see at least C7/L13-24)

As per claim 13

O'Leary/OFFICIAL NOTICE teaches the method of claim 10, as shown above.

O'Leary further teaches:

- including the terminal device communicating the particular manner of the transacting payment to the provider, and the provider effecting the electronic distribution of the prescribed portion based on the manner of such payment (see at least C7/L13-24)

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Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas M. Hammond III whose telephone number is 571-270-1829. The examiner can normally be reached Monday - Friday, 7AM - 5PM EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on 571-272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Thomas M Hammond III
Patent Examiner, Art Unit 3695
US Patent & Trademark Office
22 December 2009

/Thu Thao Havan/
Primary Examiner, Art Unit 3695